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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,934	11/16/2001	Gregory L. Heacock	13421US01	2885

7590 02/20/2003

McANDREWS, HELD & MALLOY, LTD.  
34th Floor  
500 W. Madison Street  
Chicago, IL 60661

EXAMINER

MANUEL, GEORGE C

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 02/20/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/990,934**

Applicant(s)  
**Heacock**

Examiner  
**George Manuel**

Art Unit  
**3737**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 4, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16, 32-44, and 58-64 is/are allowed.
- 6) ☒ Claim(s) 17-23, 27, 31, 45-49, 51-57, 65, 67, and 71 is/are rejected.
- 7) ☒ Claim(s) 24-26, 28-30, 50, 66, and 68-70 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

1. ***Claim Rejections - 35 U.S.C. § 112***

2. Claims 65, 67 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims 65, 67 and 71 are indefinite because the defining equation does not have the variable specified.

3. ***Claim Rejections - 35 U.S.C. § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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5. Claims 17, 27, 31 and 45 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryder '968.

Ryder shows a holder comprising a eutectic material which melts in response to a temperature change in the holder's environment. The examiner is interpreting a disposable ophthalmic lens to comprise the contact lenses for use with the holder.

*Claim Rejections - 35 U.S.C. § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-23, 45, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryder '968.

Ryder shows all of the claimed features except for the change in appearance being reversible or the composition/structure of the contact lenses.

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One of ordinary skill in the art would have found it obvious to raise the temperature to a point where the container itself melts because it is well known to use a stove for example to sterilize, and to provide a temperature beyond that required to sterilize is common.

Polymethylmethacrylate represents an obvious and well known lens composition and injection molding, compression molding, lens casting, and lens machining represent obvious and well known ways to construct a contact lens.

7. Claims 45-49, 51-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al '323.

Johnson et al show all of the claimed features except for a package enclosing the holder, or the composition of the holder or lenses.

One of ordinary skill in the art would have found it obvious to form the lens of polymethylmethacrylate for the reason state above.

One of ordinary skill in the art would have found it obvious to comprise the holder of acrylic, styrene, or polycarbonate because these are well known materials for construction, and have characteristics which are well known to impart light weight and strong structures.

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One of ordinary skill in the art would have found it obvious to enclose the holder in a sterile package because it is well known in the medical arts to use sterile packaging to avoid patient infection.

8. *Allowable Subject Matter*

9. Claims 1-16, 32-44 and 58-64 are allowed.

10. Claim 24-26, 28-30, 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 66 and 68-70 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (703) 308-2118. The examiner can normally be reached on Mon.- Fri., 9:00-5:00.


The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
George Manuel  
Primary Examiner  
Art Unit: 3737  
February 12, 2003